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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	12369.SUS01	7081

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/175,589

Applicant(s)

JACOBSON, ANDREA M.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Claims 1-22 are pending. Claims 1-2, 4-6, 10, 12-18, and 20-22 have been amended in this communication filed 10/07/02 entered as Amendment C, paper no. 16.
2. The Extension of Time filed 10/07/02 has been entered as paper no. 15.
3. The Associate Power of Attorney filed 10/07/02 has been entered as paper no. 17.
4. The claim objections cited in the Office Action of 03/29/02 to claims 1, 13, and 17 have been overcome by Applicant's amendment to claims 1, 13, and 17 and are hereby withdrawn. However, Applicant's new amendments to claims 1, 13, and 17 still leave the claims objected to (see the Objections below).

***Claim Objections 37 CFR 1.75***

5. Although Applicant's claims 1, 10, and 13 meets the requirement of 112/2d, i.e. the metes and bounds are determinable, the grammar and use of terminology could be improved. Examples are on line 12 of claim 1 the term "central depository" would be better represented as "central repository". Claim 13 has a similar problem. Claim 10, line 2 would be better represented as "...recipient of the electronic record." It is in the best interest of the patent community that the Applicant, in his normal review and/or rewriting of the claims, to take into consideration this editorial situation and to make changes as necessary.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,245,532) Mourier in view of (US 5,786,817) Sakano et al, hereafter Sakano.

With respect to claim 1, Mourier teaches, creating an electronic tag that uniquely identifies the electronic record (col. 4, lines 10-12 and lines 49-68 and col. 5, lines 1-16); storing the at least one electronic tag in a central repository (col. 4, lines 12-15); sending the electronic record to a recipient (col. 4, lines 15-18 and col. 8, lines 44-57); and the recipient will be unable to delete the record from the central repository prior to the end of the minimum time period (col. 9, lines 40-57, fig. 10C, 12A, 12B, and 13C).

Mourier did not explicitly teach, the tag having at least one field for characterizing the record. However, Mourier does implicitly teach in col. 8, lines 12-21 ("... the tag field will indicate yymmdd showing that year, month, and day are reserved for two digits each. The user will fill these fields in. All above fields will be made alterable except "document Number and Receive Date" –one field for characterizing record).

Mourier did not teach, at least one of the steps of creating and storing ensure maintenance of the characterized record for a minimum time period based on the retention policy.

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Sakano discloses at least one of the steps of creating and storing ensure maintenance of the characterized record for a minimum time period based on the retention policy (col. 1, lines 42-49, col. 2, lines 22-26 and lines 36-67, and col. 3, lines 1-10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least one of the steps of creating and storing ensure maintenance of the characterized record for a minimum time period based on the retention policy and to modify in Mourier because such a modification would allow Mourier to when the user makes an entry in an area of the tablet 9 which is superimposed on the displayed "RETENTION PERIOD" and to have the information management apparatus start a mode for a retention period.

With respect to claim 2, Mourier teaches, purging the electronic record comprising the steps of deleting the electronic record and selectively deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B).

With respect to claim 3, Mourier teaches, the step of storing the electronic record (col. 3, lines 24-38).

With respect to claim 4, Mourier teaches, the sending step further comprises the step of selectively determining whether the recipient may purge the electronic mail (col. 9, lines 20-28).

With respect to claim 5, Mourier did not teach, analyzing a network user's workstation specifications and the electronic tag being generated from information analyzed in the at least one of the network user's workstation, the network user's user profile, and the reference code.

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Mourier teaches, analyzing a network user's user profile (col. 5, lines 26-45); generating a reference code (col. 2, lines 61-64); and a network user's user profile, (col. 2, lines 58-68 and col. 3, lines 1-2).

Mourier did not teach, analyzing a network user's workstation specifications and the electronic tag being generated from information analyzed in the at least one of the network user's workstation. Sakano discloses, analyzing a network user's workstation specifications (col. 2, lines 15-35), analyzing a network user's profile (col. 4, lines 12-16), and wherein the electronic tag is generated from information analyzed in the at least one of the network user's workstation, the network user's user profile, and the reference code (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to analyze a network user's workstation specifications and wherein the electronic tag is generated from information analyzed in the at least one network user's workstation, the network user's user profile, and the reference code and to combine Mourier's network user's user profile, reference code, and electronic tag with Sakano's analyzing a network user's workstation specifications and the electronic tag being generated from information analyzed in the at least one network user's workstation, the network user's user profile, and the reference code because such a combination would allow Mourier and Sakano's systems to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, Mourier teaches, reading the stored electronic tags and generating a further electronic tag in response to accessing an electronic record (col. 4,

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lines 18-36). Sakano discloses reading the stored electronic tags and generating a further electronic tag in response to accessing an electronic record (col. 4, lines 9-16).

Together Mourier and Sakano teach the claim limitations of claim 6.

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.

With respect to claim 8, Mourier teaches a classification code and an index code (col. 4, lines 49-68, col. 5, lines 1-6, and col. 8, lines 24-34). Sakano discloses a classification code and an index code (col. 4, lines 35-65). Together Mourier and Sakano teach the claim limitations of claim 8.

With respect to claim 9, Mourier teaches business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 7, lines 7-16). Sakano discloses business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 4, lines 9-16).

The nature of E-mail does not entitle any patentable weight.

With respect to claim 10, Mourier teaches, the index code identifies the contents of the electronic record and the sender or recipient of the electronic record (col. 7, lines 34-41). Sakano discloses the index code identifies the contents of the electronic record and the sender or recipient of the electronic record (col. 4, lines 1-16). Together Mourier and Sakano teach the claim limitations of claim 10.

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

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With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 13, Mourier teaches, a computer system comprising at least one processor processor (col. 2, lines 26-32) and at least one memory (col. 3, lines 20-22).

This independent claim is also rejected for the similar rationale given for claim 1.

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.



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With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

***Response to Arguments***

8. Applicant's arguments filed 10/07/02 have been fully considered but they are not persuasive.

1. Applicants' argue: neither Mourier or Sakano or the references in combination, make obvious the limitations in the amended claims has been considered but is not persuasive based on Applicants' are arguing their claim amendments. The Examiner interprets Mourier as teaching the creation of an electronic tag, the tag having at least one field characterizing the record, storing the electronic tag in a central repository, sending the electronic record to a recipient, the recipient being unable to delete the record from the central repository prior to a minimum time period, purging the electronic record. Sakano discloses, creating and storing to ensure maintenance of the characterized record for a minimum time period based on the retention policy. It is interpreted that together Mourier and Sakano teach Applicants' invention.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moon (US 5,768,362) disclosed electronic mail, an alpha numeric tag and fields.

Nielsen (US 6,108,688) discloses electronic mail, receiving, storing, and creating the message.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### **Inquiries**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non-Official communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



E. Colbert  
December 22, 2002



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**